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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,334	11/09/2001	Hidekazu Nakai	450100-03694	5902

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EXAMINER

SCUDERI, PHILIP S

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/037,334

**Applicant(s)**

NAKAI, HIDEKAZU

**Examiner**

Philip S. Scuderi

**Art Unit**

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This Office Action is in response to Applicant's remarks filed May 9<sup>th</sup>, 2005. Claims 1-6 are pending.

#### *Response to Arguments*

2. Applicant submitted that Yokono is disqualified as prior art under 35 U.S.C. 103(c) since the instant application has a filing date of November 9<sup>th</sup>, 2001 and Yokono has a publication date of March 7<sup>th</sup>, 2002 and both the instant application and Yokono were, at the time the invention was made, assigned to Sony Corporation.
3. Examiner acknowledges that Applicant correctly disqualified Yokono as prior art. Examiner has provided new grounds of rejection. Accordingly, this action is non-final.

#### *Priority*

4. Examiner indicated in the First Office Action that the conditions of 35 U.S.C. 119(a)-(d) have been met. However, Examiner has determined that Sato et al. (U.S. 2002/0055969) is particularly relevant to the instant application. Therefore, Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

#### *Claim Objections*

5. Claim 6 is objected to because of the following informalities: "the program information;" in line 9. Examiner suggests "the program information comprising:". Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Sato et al. (U.S. 2002/0055969, hereinafter “Sato”).

8. In considering claim 1, Sato discloses a recording medium [fig. 3A #200], having:

a first storage region [fig. 3A #200b] in which program information describing a procedure for executing a process for establishing a connection to a predetermined server over a predetermined communication network [paragraph 0042 lines 5-10] and downloading data from the connected server is stored [paragraph 0049]; and

a second storage region [fig. 3A #200d] into which the data can be written [paragraph 0049].

9. In considering claim 6, Sato discloses a download method comprising:

a readout step of reading out [paragraph 0056 lines 1-6], from a recording medium [fig. 3A #200] having a first storage region [fig. 3A #200b] in which program information describing a procedure for executing a process for establishing a connection to a predetermined network

[paragraph 0042 lines 5-10] and downloading data from the connected server is stored [paragraph 0049] and a second storage region [fig. 3A #200d] into which the data can be written [paragraph 0049], the program information comprising:

an access step of accessing said server in accordance with the read out program information [paragraph 0056 lines 9-16];

a download step of downloading required information from said server accessed in accordance with the read out program information [paragraph 0056 lines 9-16]; and

a storage control step of storing the data acquired by the downloading into said second storage area of said storage medium [paragraph 0056 lines 9-16].

*Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato in view of Hosoe (U.S. 6,047,376).

12. In considering claim 2, Sato discloses the recording medium applied to claim 1. Sato does not disclose a third storage region having an ID unique to said recording medium stored therein. Nonetheless, such a feature was well known in the art, as evidenced by Hosoe. In a similar art

Hosoe discloses a medium [fig. 2 #35] for downloading data [fig. 3 #S11] comprising a server access program [fig. 2 (Server Access Authentication Program)] and a storage region having an ID unique to the medium stored therein [fig. 8 (Medium ID), col. 15 lines 12-17].

13. Given the teachings of Hosoe it would have been obvious to one of ordinary skill in the art to provide the recording medium with a third storage region having an ID unique to the recording medium, thereby ensuring that only clients having a legal medium are given server access [Hosoe col. 2 lines 65-67].

14. In considering claim 3, Sato-Hosoe teaches the recording medium applied to claim 2. Hosoe further discloses that the ID is used to ensure that only clients that have paid for the medium can access the server [col. 2 lines 65-67, col. 2 line 66 – col. 3 line 1]. Given the further teachings of Hosoe, it would have been obvious to ensure that only clients that have paid for the medium can access the server (i.e. manage accounting data), thereby helping to prevent profit loss.

15. In considering claim 4, Sato-Hosoe teaches the recording medium applied to claim 2. Sato discloses that various content data can be downloaded [paragraph 0056 lines 9-16]. Hosoe further discloses that the ID can be utilized by the server to identify the type of service provided [see fig. 9]. There is no reason to believe that the ID could not also be utilized to identify a type of the download data.

16. In considering claim 5, Sato-Hosoe teaches the recording medium applied to claim 2. Sato discloses that various content data can be downloaded [i.e. information from different sources (e.g. different sections of memory), paragraph 0056 lines 9-16]. Hosoe further discloses that the ID can

be utilized by the server to identify the type of service provided [see fig. 9]. There is no reason to believe that the ID could not also be utilized to identify a supply source for the download.

17. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kupka et al. (U.S. 6,434,535, hereinafter “Kupka”) in view of Hosoe.

18. In considering claim 1, Kupka teaches a recording medium [fig. 1-4 (28)], having a second storage region into which data can be written [fig. 7 (320)]. Kupta further teaches program information describing a procedure for executing a process for establishing a connection to a predetermined server over a predetermined network and downloading data from the connected server [col. 12 lines 53-55 (the application program contacting the media server)]. However, the program information (i.e. the application program) is not embodied on a first storage region of the recording medium.

19. Nonetheless, a memory medium having a first storage region in which program information describing a procedure for executing a process for establishing a connection to a predetermined server over a predetermined communication network and downloading data from the connected server was stored was well known, as evidenced by Hosoe. In a similar art, Hosoe discloses a memory medium (fig. 2 #35) having a first storage region in which program information describing a procedure for executing a process for establishing a connection to a predetermined server is stored (fig. 2 “Server Access Authentication Program”, col. 4 lines 36-37, fig. 2 “Server Address”, col. 1 lines 52-54).

20. Given the teachings of Hosoe, it would have been obvious to one of ordinary skill in the art to embody the program information on the recording medium, thereby enabling the user to quickly access the server from computers that do not have the program instructions previously installed.

21. In considering claim 2, Kupka-Hosoe teaches the recording medium applied to claim 1, further including a third storage region having an ID unique to said recording medium stored therein [Kupka col. 14 lines 56-60 (encryption/decryption key comprising a unique identifier, a vendor identifier, and a user identifier)].

22. In considering claim 3, Kupka-Hosoe teaches the recording medium applied to claim 2, wherein the ID is information which can be utilized by said server to manage accounting for the downloaded data [fig. 7 (308, 310, 312, 313, 324)].

23. In considering claim 4, Kupka-Hosoe teaches the recording medium applied to claim 2, wherein the ID is information which can be utilized by said server to identify a type of the download data [col. 15 lines 14-17 (The user identifier can be used to identify data associated with authorized users, specific departments, etc.)].

24. In considering claim 5, Kupka-Hosoe teaches the recording medium applied to claim 2, wherein the ID is information which can be utilized by said server to identify a supply source of the download data [col. 15 lines 14-17 (The user identifier can be used to identify data that the user is authorized to download.)].



25. In considering claim 6, Kupka teaches a downloading method, comprising:

a readout step of reading out program information describing a procedure for executing a process for establishing a connection to a predetermined communication network and downloading data from the connected server [col. 12 lines 53-55 (the application program contacting the media server)] and a recording medium [fig. 1-4 (28)] comprising a second storage region into which the data can be written [fig. 7 (320)], the program information;

an access step of accessing said server in accordance with the read out program information [fig. 7 (318)];

a download step of downloading required data from said server accessed in accordance with the read out program information [fig. 7 (318)]; and

a storage control steps of storing the data acquired by the downloading into said storage area of said storage medium [fig. 7 (320)].

26. Kupka does not teach that the program information (i.e. the application program) is not embodied on a first storage region of the recording medium.

27. Nonetheless, a memory medium having a first storage region in which program information describing a procedure for executing a process for establishing a connection to a predetermined server over a predetermined communication network and downloading data from the connected server was stored was well known, as evidenced by Hosoe. In a similar art, Hosoe discloses a memory medium (fig. 2 #35) having a first storage region in which program information describing a procedure for executing a process for establishing a connection to a predetermined server is stored (fig. 2 "Server Access Authentication Program", col. 4 lines 36-37, fig. 2 "Server Address", col. 1 lines 52-54).

28. Given the teachings of Hosoe, it would have been obvious to one of ordinary skill in the art to embody the program information on the recording medium, thereby enabling the user to quickly access the server from computers that do not have the program instructions previously installed.

*Conclusion*

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip S. Scuderi whose telephone number is (571) 272-5865. The examiner can normally be reached on Monday-Friday 8am-5pm.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PSS

  
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